

### **REMARKS**

Claims 1-24 are pending in the Application. Claims 8, 12, 20 and 24 have been amended. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

### **The 35 U.S.C. § 101 Rejections**

Applicants respectfully traverse with the rejections. Nevertheless, claims 8, 12, 20 and 24 have been amended. Applicants respectfully request that the 35 U.S.C. § 101 rejections be withdrawn.

### **The Legal Standard**

Before a claim may be rejected on the basis of obviousness, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Applicant is under no obligation to submit evidence of nonobviousness. MPEP § 2142.

Absent a showing of a teaching, suggestion or motivation to produce a claimed combination, an obviousness rejection is not proper. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The teaching, suggestion or motivation to combine the features in a prior art reference must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

It is respectfully submitted that the Action does not meet these burdens.

#### **The 35 U.S.C. § 103 Rejections**

For brevity, the Applicants have not necessarily presented all the reasons as to why the applied references do not render the claims obvious. Applicants reserve the right to later present additional reasons. Nevertheless, Applicants' arguments show that the applied references neither taken alone nor in combination disclose or suggest all of the steps, features and relationships of the claimed invention. Hence, Applicants' claims patentably distinguish over the applied references. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections should be withdrawn.

**The Pending Claims Are Not Obvious Over  
Jheeta in view of Bertram**

In the Action claims 1-2, 5, 8-10, 12-13, 20-22 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jheeta (US 5,619,558) in view of Bertram, et al. (US 6,049,812) ("Bertram"). These rejections are respectfully traversed.

Applicants respectfully submit that none of the applied references, taken alone or in combination, disclose or suggest the features and relationships that are specifically recited in the claims. The applied art is devoid of any teaching, suggestion or motivation for combining features of the applied art so as to produce the recited invention.

Even if it were somehow possible for the references to have disclosed certain features as alleged, it still would not have been obvious to have combined the references as alleged. Additionally, even if it were somehow possible (which it isn't) to combine these references, this would not render the resultant combination obvious because the prior art does not suggest the desirability of the combination (MPEP § 2143.01). Furthermore, even if it were somehow possible (which it isn't) for the references to be combined as alleged, the resultant combination still would not have produced Applicants' claimed invention. The Office has not established a *prima facie* showing of obviousness. Thus, Applicants respectfully submit that the 35 U.S.C. § 103(a) rejections should be withdrawn.

**Claim 1**

The Action alleges that Jheeta discloses steps (a) and (b), but admits that Jheeta fails to disclose steps (c) and (d). The Action relies on Bertram for steps (c) and (d).

Applicants respectfully submit that Bertram cannot overcome the admitted deficiencies of Jheeta as it does not disclose or suggest the recited features and relationships which are not found in Jheeta. For example, Bertram does not generate a web page responsive to a customer profile value, especially a customer profile value accessed from a data store responsive to customer identification information read with a reading device in operative connection with an automated transaction machine. Furthermore, Bertram is non analogous art. Neither Jheeta nor Bertram, taken alone or in combination, disclose or suggest the recited steps of claim 1.

The Action admits that Jheeta does not teach or suggest generating a web page and displaying the web page at an automated transaction machine. Nor is there any teaching or suggestion that Jheeta has the capability of generating a web page and displaying the web page at an automated transaction machine. Thus, it is unclear how the structure of Jheeta could include the teachings of Bertram as alleged. Furthermore, Jheeta does not need the teachings of Bertram, as a customer in Jheeta can be provided with a message printed on paper. The Action lacks motivation to combine Jheeta with the teachings of Bertram.

The attempts to modify Jheeta are clearly attempts at hindsight reconstruction of Applicants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). The rejection, which lacks the necessary evidence and rationale, is based on knowledge gleaned only from Applicants' disclosure.

The Action has not established that all of the recited features are known in the prior art. The Action lacks substantial evidence support. *In re Zurko, supra*. The Action does not

factually support any *prima facie* conclusion of obviousness. Thus, Applicants respectfully submit that the 35 U.S.C. § 103(a) rejection should be withdrawn.

#### **Claims 9, 13, and 21**

Applicants' remarks in support of the patentability of claim 1 are incorporated by reference as if fully rewritten herein. Neither Jheeta nor Bertram, taken alone or in combination, disclose or suggest the recited methods of respective claims 9, 13 and 21. It follows that the Office has not established a *prima facie* showing of obviousness.

#### **The Dependent Claims**

Each of the dependent claims depends directly or indirectly from an independent claim. The Applicants have shown the independent claims to be allowable. "If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious" (MPEP 2143.03). *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). Thus, it is asserted that the dependent claims are allowable on the same basis.

Furthermore, each dependent claim additionally recites specific features and relationships that patentably distinguish the claimed invention over the applied art. None of the references, taken alone or in combination, discloses or suggests the features and relationships that are specifically recited in the dependent claims. Thus, it is respectfully submitted that the dependent claims are further allowable due to the recitation of such additional features and relationships.

Versions With Markings To Show Changes Made

In the Claims

A2

8. (once amended) Computer readable media having computer readable instructions embodied thereon, the computer readable instructions operative to cause [a] at least one computer to carry out the method steps recited in claim 1.

A3

12. (once amended) Computer readable media having computer readable instructions embodied thereon, the computer readable instructions operative to cause [a] at least one computer to carry out the method steps recited in claim 9.

A4

20. (once amended) Computer readable media having computer readable instructions embodied thereon, the computer readable instructions operative to cause [a] at least one computer to carry out the method steps recited in claim 13.

A5

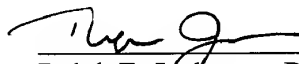
24. (once amended) Computer readable media having computer readable instructions embodied thereon, the computer readable instructions operative to cause [a] at least one computer to carry out the method steps recited in claim 21.

### Conclusion

Each of Applicants' pending claims specifically recite features and relationships that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion or motivation for combining features of the applied art so as to produce Applicants' invention. Allowance of all of Applicants' pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,



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